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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,664	12/20/2001	Stuart J. Solomon	12587-022001 / 01316-00/U	1128
26212	7590	09/29/2004	EXAMINER	
FISH & RICHARDSON P.C. 225 FRANKLIN STREET BOSTON, MA 02110			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,664

Applicant(s)

SOLOMON ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13-16,18-21,23-26 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16,18-21,23-26 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Claims 2, 7, 12, 17, 22 and 27 have been canceled. New claims 29-34 have been added. Claims 1, 3, 4-6, 8-11, 13-16, 18-21, 23-26 and 28-34 are currently pending in the application.

Claim rejections under 35 USC § 102 have been withdrawn due to applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 2002/0169664) in view of Gharavy (US 2003/0004840).

Walker et al. (Hereinafter Walker) teaches a method and system for providing offers using a billing statement, comprising:

Claims 1, 6, 11, 16, 21 and 26. Receiving information (data) related to at least one business transaction [0192]; converting said information from a first format to another format [0048]; determining whether said received information satisfies at least one configurable business rule [0192], wherein the configurable business rule specifies a relationship between the received business transaction and the subsequent business transaction [0192]; [0155]; [0157]; establishing information related to subsequent business transaction based on said determination [0192]; [0155]; [0157].

Walker does not specifically teach *validating said information related to at least one business transaction; and enabling the market participant to track a*

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status of said information related to the business transaction and the subsequent business transaction. Also, Walker does not specifically teach that said another format is a *standard* format.

Gharavy teaches a method and system for performing collective validation of credential information, wherein:

credential data of a transaction is *validated* [0025]; [0105];

during said validation said data is *converted* in the format usable by the rule engine, for example *standard format* [0025]; [0105];

tracking information related to said credential data [0030].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker to include validating said information related to at least on business transaction; and tracking information related to said credential data, as disclosed in Gharavy, because it would advantageously enhance accuracy of the system, and make it more secure. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker to include that said data is converted in the standard format, as disclosed in Gharavy, because it would advantageously simplify the processing of said data.

Claims 3, 8, 13, 18, 23 and 28. Walker teaches said method and system, wherein the configurable business rule is configured based on at least one of a jurisdiction associated with the received business transaction, a time relationship between the received business transaction and a subsequent business transaction, and a business event associated with the received business transaction [0162].

Claims 4, 9, 14, 19 and 24. Walker teaches processing business transactions representing different formats [0048].

Claims 5, 10, 15, 20 and 25. Walker teaches rejecting a requested transaction if this transaction does not satisfy business rules [0093].

Claims 29-34. Walker teaches receiving information (data) related to at least one business transaction [0192]; and determining whether said received

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information satisfies at least one configurable business rule [0192], wherein the configurable business rule specifies a relationship between the received business transaction and the subsequent business transaction [0192]; [0155]; [0157]. Information as to *specific content of said received information and specific content of said business rules* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Walker in view of Gharavy would be performed the same regardless of the content of said received information and the content of said business rules.

Response to Arguments

Applicant's arguments filed 6/18/04 have been fully considered but they are not persuasive.

In response to the applicant's argument that prior art does not disclose: *validating said information related to at least one business transaction; mapping said information from a first format to a standard format; and enabling the market participant to track a status of said information related to the business transactions*, it is noted that Gharavy was applied for these features. Specifically, Gharavy teaches: validating credential data of a transaction [0025]; [0105]; converting said credential data in to the standard format [0025]; [0105]; and tracking information related to said credential data [0030]. The motivation to combine Walker and Gharavy would be to enhance security of the system, and simplify the processing of said data (See discussion above).

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

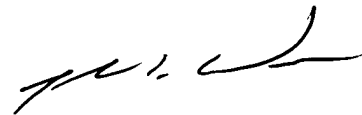
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(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

9/12/2004



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600